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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,996	03/30/2004	Kagumi Moriwaki	032817-009	2677

21839 7590 02/20/2009  
BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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02/20/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,996	<b>Applicant(s)</b> MORIWAKI, KAGUMI	
	<b>Examiner</b> SAEID EBRAHIMI DEHKORDY	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

1. Examiner acknowledges that the allowable subject matter of claims 2 and 8 are written in independent form, However update search has revealed the new prior arts which would read on the claims as amended.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (U.S. patent 7,444,382) in view of Sharpe (U.S. patent 6,700,591)

**Regarding claim 2** Malik discloses: A data communication device comprising: a file memory portion for storing a first file (column 3, lines 5-17) a transmission information setting portion for setting transmission information necessary for sending the first file to a recipient (note column 1, lines, 30-34 and 54-67, wherein the recipient address is generated from the receiving email) a file generation portion for generating a second file by adding the transmission information to the first file; a transmission portion for sending the generated second file to the recipient (note column 1, lines 30-40 wherein the designated document or file is added to the email). However Malik does not clearly disclose: a display setting portion for setting whether or not the transmission information is displayed, wherein the file generation portion generates the second file by setting a font used for displaying the transmission information to transparent when the display setting portion sets that the transmission information is not displayed. On the other

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hand Sharpe discloses: a display setting portion for setting whether or not the transmission information is displayed, wherein the file generation portion generates the second file by setting a font used for displaying the transmission information to transparent when the display setting portion sets that the transmission information is not displayed (note column 10, lines 13-29, wherein the colored font are used for transparencies, to determine the transmission information such as date and time or size of the email, which will be displayed on the screen).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Malik's invention according to the teaching of Sharpe, Where Sharpe in the same field of endeavor teaches the way the transparent fonts are used for better identification of the transmission information, This would in fact enhance the system in terms of security and performance.

**Regarding claim 8** Malik discloses: A data communication device comprising: a file generation portion for generating a second file by adding a first file transmission information for sending the first file to a recipient (note column 1, lines 30-40 wherein the designated document or file is added to the email) a file storage portion for storing the generated second file in a storage medium (this limitation is well know in the art as for instance when the email message was composed and sent the copy of the file would be saved in to the "sent item" including the attachment or "second file" for instance Microsoft out look). However Malik does not clearly disclose: a display setting portion for setting whether or not the transmission information is displayed, wherein the file generation portion generates the second file by setting a font used for displaying the transmission information to transparent when the display setting portion sets that the transmission information is not displayed. On the other hand Sharpe discloses: a display

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setting portion for setting whether or not the transmission information is displayed, wherein the file generation portion generates the second file by setting a font used for displaying the transmission information to transparent when the display setting portion sets that the transmission information is not displayed (note column 10, lines 13-29, wherein the colored font are used for transparencies, to determine the transmission information such as date and time or size of the email, which will be displayed on the screen). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Malik's invention according to the teaching of Sharpe, Where Sharpe in the same field of endeavor teaches the way the transparent fonts are used for better identification of the transmission information, This would in fact enhance the system in terms of security and performance.

### **CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeid Ebrahimi-dehKordy whose telephone number is 571-272-7462. The examiner can normally be reached on Mon-Fri, 8:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Saeid Ebrahimi-dehKordy/  
Primary Examiner, Art Unit 2625  
February 5, 2009